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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/040,825	03/18/98	FRYBERG	M ICH275

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IM22/0424

EXAMINER	
YAMNITZKY, M	
ART UNIT	PAPER NUMBER
1774	19

DATE MAILED: 04/24/01

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☒ is extended to run \_\_\_\_\_ or continues to run 3 months from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).
- ☒ Applicant's response to the final rejection, filed 04/16/01 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☒ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
  - b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
  - c. ☐ They raise the issue of new matter. (See Note).
  - d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
  - e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See Attached

2. ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☒ will not be entered and the status of the claims will be as follows:

Claims allowed: None

Claims objected to: None

Claims rejected: 3-13 for reasons of record

However; See Attached

☐ Applicant's response has overcome the following rejection(s): \_\_\_\_\_

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because See attached
5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other (2 page attachment.)

MLR  
04/24/01

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Attachment to Advisory Action (Paper No. 19) - PTOL-303

1. (cont'd)

The proposed amendments to the claims will not be entered and the final rejection stands because the amendment filed on 04/16/01 is considered non-compliant because it fails to meet the requirements of 37 CFR 1.121, as amended on September 8, 2000 (see 65 Fed. Reg. 54603).

37 CFR 1.121(c) requires submission of a clean (with no underlining or bracketing that is not part of the claimed subject matter) amended claim with an instruction to substitute it for the pending claim with the same number, and requires submission of a marked-up version of the prior pending claim with all changes shown by any conventional comparison system. Both the clean amended claim and the marked-up version should have the same expression: "amended", "twice amended", etc., in parentheses after the claim number.

In the proposed amendment filed 04/16/01, the clean copy of proposed amended claim 12 contains underlining that is not part of the claimed subject matter. The clean copy of proposed amended claim 12 does not contain the expression "Twice Amended" in parentheses after the claim number. The clean copy of proposed amended claim 13 does not contain the expression "Amended" in parentheses after the claim number.

APPLICANT SHOULD RE-SUBMIT THE AMENDMENT IN COMPLIANCE WITH 37 CFR 1.121 WITHIN THE TIME REMAINING IN THE PERIOD SET IN THE FINAL REJECTION. IF FILED AFTER THE SHORTENED STATUTORY PERIOD OF THREE

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MONTHS FROM THE DATE SET IN THE FINAL REJECTION, THE RESPONSE MUST BE ACCOMPANIED BY A REQUEST FOR EXTENSION OF TIME (WITH FEE) UP TO THE FULL STATUTORY PERIOD, IF NEEDED.

Applicants are requested to present the clean copy of the proposed amended claims with all text permanently imaged on the paper. The clean copy of proposed amended claims 12 and 13 includes the formula for the copolymer on separate smaller pieces of paper that are taped to a larger sheet of paper containing other text of these claims.

3. (cont'd)

If applicant re-submits the amendment in compliance with 37 CFR 1.121 as set forth above, the proposed amendment will be entered upon the filing of an appeal and the rejection under 35 U.S.C. 112, second paragraph, as set forth in Paper No. 17, will be overcome. The status of the claims will be as follows:

Claims allowed: None

Claims objected to: None

Claims rejected: 3-13 under 35 U.S.C. 103(a) as being unpatentable over Kono et al. or Kashiwazaki et al., either patent taken in view of Smigo et al. for reasons of record.

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4. (cont'd)

The request for reconsideration has been considered but does not overcome the prior art rejection because the examiner maintains the position set forth in the rejection of record and in the response set forth in Paper No. 17 to applicant's prior arguments. In particular, the examiner maintains that the prior art provides sufficient motivation to provide a recording sheet containing the copolymer of the structure set forth in present claims 12 and 13 in the amount required by the present claims. The prior art's lack of teachings regarding improved light fastness obtained by the use of the cationic polyvinyl alcohol does not render the presently claimed recording sheet non-obvious because the prior art provides other motivation for using the particular cationic polyvinyl alcohol required by the present claims. Also, as noted in Paper No. 17, the present claims place no positive limitation on the light fastness of the claimed recording sheet.

Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (703) 308-4413. The examiner can generally be reached at this number from 6:45 a.m. to 3:15 p.m. Monday-Friday.

The current fax numbers for Art Unit 1774 are (703) 305-3599 for official after final faxes and (703) 305-5408 for all other official faxes. (Unofficial faxes for Art Unit 1774 can be sent to (703) 305-5436.)

MRY  
04/24/01



MARIE YAMNITZKY  
PRIMARY EXAMINER

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